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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,814	06/16/2000	Daniel Schreiber	5016	6584

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EXAMINER

YUAN, ALMARI ROMERO

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/28/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/595,814

Applicant(s)

SCHREIBER ET AL.

Examiner

Almari Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 6, 11, 12, 13, and 14. 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: Application filed on 6/16/00, Preliminary Amendment filed on 6/15/00, and IDSs filed on 7/24/00, 4/09/01, 2/19/02, 2/28/02, 6/19/02, and 8/16/02.

2. Original present claims 6-18 and 23-33 are cancelled. Claims 1-5 and 19-22 are pending in the case. Claims 1 and 19 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Israel on 6/14/1998. It is noted, however, that applicant has not filed a certified copy of the 124895 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

4. The following references were not placed in the application file and the Examiner is requesting Applicant to re-submit these references to be properly considered:

IDS filed on 7/24/00: On page 1, item AM: Chapter 3 – Understanding Image Guardian, item AN: Chapter 3 – Understanding Web Referee, item AO “Copysight”; on page 2, item AP: “Copysight: Now You Can Protect Your Website Content on the Internet with Copysight’s Suite of Software and Business Solutions”, item AQ: “Digimarc & Copyright Protection”, item AR: “Digital Rights Management”; on page 3, item AS: “SafeImage”, item AT: “SiteShield” press release, item AU: “SiteShield” products details, item AV: “Softlock.Com”, item AW: Strom, D., “Browser: Protect Your Image on the Web”.

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The information disclosure statement filed 7/24/00 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Referring to the IDS on page 1, the listed documents of items AM thru AO are not identified by a publisher and date; the document of item AO is not identified with relevant pages; on page 2, items AP thru AR are not identified with a publisher and relevant pages of the publication; the document of item AR is not identified with a date; on page 3, items AS thru AW are not identified with a publisher and relevant pages of the publication, items AS thru AV are not identified with a date.

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

The information disclosure statement (IDS) submitted on 4/09/01, 02/19/02, 2/28/02, 8/16/02, and 6/19/02 has been considered by the Examiner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 4-5, 19-20, and 22 rejected under 35 U.S.C. 102(e) as being anticipated by Marmor (USPN 6,601,108 B1 – provisional filed on 03/1997).

Regarding independent claims 1 and 19, Marmor discloses:

A method for providing textual information in a network environment, the method comprising:

receiving a request via a network for text-editable textual information; sending said non-text-editable textual information via said network (on col. 4, lines 35-41 and col. 5, lines 26-43: teaches client downloads (request) information from the server; the requested information can be sent by the server via);

converting said text-editable textual information into a non-text-editable textual format on line upon receiving said request (on col. 5, lines 3-17: teaches converting text data into an image data (for example a GIF format data) to be displayed on the client).

Regarding dependent claims 2 and 20, Marmor discloses:

a non-text-editable graphical representation of said text-editable-textual information (on col. 5, lines 3-17: teaches the conversion of text data into an image data; wherein the image data can be a GIF format data).

Regarding dependent claim 4, Marmor discloses:

displaying said non-text-editable textual information via a computer terminal display (on col. 5, lines 8-11: teaches converted image files for display on the client).

Regarding dependent claims 5 and 22, Marmor discloses:

computer terminal connected to said network at a server (see figures 1A-1B), converting performed at said server (on col. 5, lines 3-17: teaches all data from the server is converted into

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data usable by the client), server sending said non-text-editable information to said computer terminal via said network (on col. 4, lines 35-41 and col. 5, lines 3-44, see figures 1A-1B: teaches the server can send converted data to the client when the client request download of an information).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marmor as applied to claims 1-2, 4-5, 19-20, and 22 above, and further in view of LeMole et al. (USPN 6,009,410 – filed on 10/1997).

Regarding dependent claims 3 and 21, Marmor discloses the invention substantially as claimed as described *supra*. However, Marmor does not explicitly disclose “graphical representation comprises at least one hyperlink”.

LeMole on col. 2, lines 28-33, see Abstract: teaches user can click on image to retrieve through hyperlink further information; images, banners, etc. are user for presenting textual and/or visual information.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified LeMole into Marmor to provide a hyperlink with an image

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as taught by LeMole, incorporated into the converted image data of Marmor, in order to enhance the presentation of information to be displayed to a user on the Web.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


USPN 5,968,119 – Stedman et al. – filed on 12/1996

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AY
August 22, 2003


SANJIV SHAH
PRIMARY EXAMINER